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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,593	06/07/2001	Benoit Van Den Eynde	L0461/7099	9143

7590 01/29/2003

Wolf Greenfield & Sacks  
Federal Reserve Plaza  
600 Atlantic Avenue  
Boston, MA 02210-2211

EXAMINER
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YU, MISOOK

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 01/29/2003

1  
H/S

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/674,593

Applicant(s)

EYNDE ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8, 9, 12, 13, 25, 66, 67, and 71-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☒ Other: See Continuation Sheet

Continuation of Disposition of Claims: Claims pending in the application are 1,2,8,9,12,13,15,19,21,22,25,29,30,35,36,38,41,44,47,48,50,54,56-62 and 65-79.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 15,19,21,22,29,30,35,36,38,41,44,47,48,50,54,56-62,65,68-70 and 77-79.

Continuation of Attachment(s) 6). Other: Seq. alignment and Changes to the Patent Rules.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of group II corresponding to claims 1, 2, 8, 9, 12, 13, 25, 66, 67, 71-78 as drawn to SEQ ID NO:1-3) in Paper No. 14 is acknowledged. The traversal is on the ground(s) that the two sequences applicant named as RUR-1 sense and RUR-1 antisense are related because they appear to be expressed from the same gene. This is not found persuasive because RUR-1 sense and RUR-1 antisense do not share a special technical feature. Further, they are not expressed from the same gene. RUR-1 antisense is encoded within another gene from its antisense strand. Note Fig. 1 of Peltz et al (1999, J. Exp. Med. Vol. 190, pages 1729-1731). They are two different, unrelated products encoding two unrelated, different human proteins with expression patterns. Note Fig. 3, 7, and Table 1 of Eynde et al (1999, J. Exp. Med. Vol. 190, pages 1793-1799). They have different molecular structures as shown in the sequence alignment provided in the previous Office action (see Paper No. 13). This examiner notes typographical error including claims 77, and 78 in group II in the previous Office action (restriction requirement). Claims 77 and 78 are drawn to method of using the products of groups I-V, therefore it should belong to groups VI-IX. Therefore claims 77, and 78 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. The requirement is still deemed proper and is therefore made FINAL.

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Claims 15, 19, 21, 22, 30, 35, 36, 38, 41, 44, 47, 48, 50, 54, 56-62, 65, 68-70, 77-79 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

Claims 1, 2, 8, 9, 12, 13, 15, 19, 21, 22, 25, 29, 30, 35, 36, 38, 41, 44, 47, 48, 50, 54, 56-62, and 65-79 are pending and 1, 2, 8, 9, 12, 13, 25, 66, 67, and 71-76 are examined on merits as to the extent they are drawn to the second product of the instant claim 1, i.e., SEQ ID NO:1 and its fragments.

### ***Response to Amendment***

The amendment to the claims filed on 6-7-2001 (Paper No. 7) does not comply with the requirements of 37 CFR 1.121(c) because the amendment does not have clean copy. Amendments to the claims filed after March 1, 2001 must comply with 37 CFR 1.121(c) which states:

(c) Claims.

(1) Amendment by rewriting, directions to cancel or add: Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Applicant is requested to provide a clean copy version of the claims. Note the attached "Changes to the Patent Rules".

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***Claim Objections***

Claims 1, 2, 8, 9, 12, 13, 25, 71-76 are objected to because of the following informalities: The instant claims are not amended to reflect the election; they are still *fixed* drawn to multiple inventions. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 2, 8, 9, 12, 13, 25, 66, 67, and 71-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is confusing in light of the dependent claims 2 and 66 because claim 1 appears to drawn to a nucleic acid molecule comprising SEQ ID NO:1 but claims 2 and 66 which depend on claim 1 appear to be drawn a smaller fragment of SEQ ID NO:1, i.e., the coding region of SEQ ID NO:1. Therefore it is not clear if claim 1 is drawn to a nucleic acid molecule comprising SEQ ID NO:1 or drawn to a nucleic acid molecule comprising a part of SEQ ID NO:1.

Claim 8 recites "a unique fragment" but it is not clear what the metes and bounds *fixed* are for the limitation.

Claim 9 is confusing because the claim uses Markush format, "something is selected from the group consisting of... **and** something" and it is not clear whether the *fixed* limitation after ";" in line 6 is some more species of the Markush group. If they are, proper Markush group format would obviate this rejection.

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Claim 25 recites the limitation "the contiguous segments" in the last line. There is insufficient antecedent basis for this limitation in the claim.

fixed

Claim 25 is confusing because it is not clear what should be "nonoverlapping". Is it mean a forward and a reverse primers in a kit are not overlapping?

fixed

Claims 74 and 75 are confusing because claim 74 is drawn to kit containing a pair of primers capable of amplifying a nucleic acid molecule comprising SEQ ID NO:1. However, the specific primers in claim 75 do not appear to be capable of amplifying an isolated nucleic acid molecule comprising SEQ ID NO:1 because SEQ ID NO:8 and SEQ ID NO:9 hybridize nucleotide 523-547 and 1304-1280 of SEQ ID NO:1 respectively, which will lead to amplify only a portion of SEQ ID NO:1, not the entire SEQ ID NO:1.

fixed

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 8, 9, 71, and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. 5,582,979 (Dec. 10, 1996).

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Claims 8, 9, 71, and 72 are drawn to a fragment of SEQ ID NO:1. US Pat. 5,582,979 teaches a fragment of the instant SEQ ID NO:1. Note the attached sequence alignment.

*maintain*

Claims 8, 9, 71, and 72 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. 6,087,485 (filing date: Jan. 21, 1998).

Claims 8, 9, 71, and 72 are drawn to a fragment of SEQ ID NO:1. US Pat. 6,087,485 teaches a fragment of the instant SEQ ID NO:1. Note the attached sequence alignment.

### **Conclusion**

No claim is allowed.

SEQ ID NO:1 is free of art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.




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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu  
January 22, 2003



ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1000